

REMARKS

Reconsideration of the subject application in view of the above amendment is respectfully requested.

Claim 6 has been amended.

Based on the foregoing amendment and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

I. Rejection of the Claims

Ia. Rejection Under 35 U.S.C. §112

The Examiner has rejected claim 6 under 35 U.S.C. §112, second paragraph, for being indefinite. The Applicant has amended the claim to overcome this rejection. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 6 under 25 USC 112, second paragraph.

Ib. Rejection of claims under 35 USC §102(b)

The Examiner has rejected claim 1 under 35 U.S.C. §102(a), as being anticipated by U.S. patent 5,213,247 to Gschwend et al (Gschwend). Applicant respectfully disagrees with this rejection.

Gschwend discloses an internal combustion powered tool for driving fastening elements that has a piston (7) guided cylinder (8) and a combustion chamber (9). The first rear partial chamber (9c) is connected with a passageway/opening (10d) for supplying an air fuel mixture into the combustion chamber (9) (c.5:5-8). The opening (10d) is closed at a certain stage by pressing of the trigger (c14:36-38). Further, an exhaust gas passageway (16) turns off from the front most partial chamber (9a). The exhaust gas passageway (16) can be closed by a check valve (17) (c15:38-42; c4:33-37; Fig. 2). No magnet means are involved in the closing/opening processes of these openings passageways (10d, 16).

Permanent magnets (7b) on the other hand serve for temporary retention of the piston 7, 7a at the combustion chamber wall 11 during periods of the device (4:20-22). No other function of these magnets (7b) is disclosed in Gschwend. Thus, claim 1 is patentable over Gschwend.

The Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation...[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

In view of the above, since Gschwend fails to disclose all the features of claim 1, it is respectfully submitted that Gschwend does not anticipate the present invention, as defined by claim 1. It is respectfully submitted that claim 1 is patentable over the prior art. Accordingly, withdrawal of the rejection to claim 1 under 35 U.S.C. § 102(b) is respectfully requested.

Ic. Rejection of claims under 35 USC §103(a)

The Examiner has rejected claims 2-4 and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Gschwend in view of U.S. Patent No. 6,217,626 to Mac Vicar (Mac Vicar). Applicant respectfully disagrees with this rejection.

It is respectfully submitted that the present invention, as defined in independent claim 1 and claims 2-4 and 6-8 that depend therefrom, would not be obvious over such references.

Neither Gschwend or Mac Vicar disclose or teach a locking and unlocking mechanism that has a magnet for detecting a drive piston in the starting position.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also *In re Sernaker*, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. In re Jones 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the

Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicants’ own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

There is nothing in the prior art that would suggest combining such references to achieve the claimed invention.

In view of the above, it is respectfully submitted that none of the references alone or in combination make the present invention, as defined in Claim 1, obvious, and the present invention is patentable over such referenced.

Claims 2-4 and 6-8 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in

Claim 1, are not disclosed or suggested in the prior art. Accordingly,

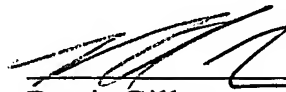
Applicants respectfully request withdrawal of the rejection to claims 2-4 and 6-8 under 35 USC 103 (a) over such prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,



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